

REMARKS

Claims

Upon entry of this Amendment, claims 169-180 will be pending in the subject application. By this Amendment, Applicants have amended claim 180. On page 2 of the May 2, 2007 Office Action, the Examiner advises that the Amendment submitted February 12, 2007 corrected the dependency of claim 180 to depend on 179, but the amended claim was mislabeled as "previously entered". In response, Applicants hereby re-submit amended claim 180 with the proper claim status identifier, "currently amended".

Applicants maintain that the Amendment to claim 180 raises no issue of new matter. Accordingly, Applicants respectfully request that the Amendment be entered.

Double Patenting

On page 2-5 of the May 2, 2007 Office Action, the Examiner rejects claims 169-180 on the grounds of nonstatutory obviousness double patenting as allegedly being unpatentable over claims 1-8 of U.S. Patent No. 6,221,616, and over claims 1-9 of U.S. Patent 6,291,195. The Examiner acknowledges that the conflicting claims are not identical, yet alleges that the claims are not patentably distinct from each other.

In response to the nonstatutory obviousness double patenting rejection, Applicants will consider filing a Terminal Disclaimer with respect to U.S. Patent No. 6,221,616 and U.S. Patent 6,291,195 upon the indication of allowable claims in the subject application.

Rejection under 35 U.S.C. §112, first paragraph

On page 5 of the May 2, 2007 Office Action, the Examiner rejected claims 169-180 under 35 USC §112, First Paragraph, for allegedly failing to comply with the written description requirement. The Examiner alleges that the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse the rejection for the following reasons.

Applicants clearly describe the claimed invention, which is a method for determining whether a chemical compound is a human MCH1 receptor antagonist, in which the method uses a known MCH receptor agonist. The specification and the prior art teach that an agonist of the MCH1 receptor may be MCH or an analog or homolog thereof. (See e.g. the specification on page 57, lines 28-29.) Analogs and homologs of the MCH peptide were known at the time the specification was filed. See e.g. Drozd et al., 1995, FEBS Letters, Vol. 359, pgs. 199-202, and Matsunaga et al., 1989, Peptides, Vol. 10, pgs. 349-354; copies of which are attached herewith. Further, the specification describes activation of the human MCH1 receptor by MCH and Phe¹³, Tyr¹⁹-MCH (see page 99, lines 20-29, and Figure 8), as measured microphysiometrically, which is described on pages 91-92 of the specification. Consequently, because of the knowledge of one skilled in the art as exemplified by prior art, and the teachings of the specification, the subject matter of the subject application reasonably conveys to one skilled in the art that the inventors had possession of the present invention at the time the subject application was filed.

Applicants, therefore, respectfully request that the Examiner reconsider and withdraw the written description rejection under 35 USC §112, First Paragraph.

Conclusion

In light of the remarks and amendments, Applicants believe that the claims are in condition for allowance, and earnestly solicit allowance of the pending claims.

If a telephone interview would be of assistance in advancing prosecution of the above-identified application, the Examiner is invited to telephone Applicants' undersigned attorney at the number provided.

No fee, other than the fee for a two month extension of time, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to the Commissioner to charge such fee, or credit any overpayment, to Deposit Account No. 50-3201.

Respectfully submitted,

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